

REMARKS

Applicants respectfully request reconsideration in view of the amendments submitted herein and the accompanying remarks. Clarifying amendments have been made to Claims 1, 4, 10, 20, and 24. New Claims 25 and 26 have been added. Therefore, Claims 1, 4-6, 10, and 20-26 are pending in the present application.

Claims 1, 4-6, 21, and 23 were rejected in an Office Action mailed December 26, 2007 ("Office Action"), under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,137,517, issued to Loney et al. ("Loney"), in view of U.S. Patent No. 4,057,186, issued to Hedger ("Hedger"). Claims 10 and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Loney in view of Hedger, in further view of U.S. Patent No. 6,533,772, issued to Sherts et al. ("Sherts"). Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Sherts. Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Hedger and further in view of Sherts. For the following reasons, applicants assert that the present application is in condition for allowance.

Claim Rejections Under 35 U.S.C. § 102

Claims 10 and 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Loney in view of Hedger, in further view of Sherts. Applicants traverse the rejections to these claims. Since the Office Action at paragraphs 11-15 appears to be rejecting Claims 10 and 24 as being unpatentable under Section 103, and since the rejections are found under the general heading "Claim Rejections - 35 USC § 103" in the Office Action, applicants believe that the rejections under Section 102 were in error. Thus, the discussion of Claims 10 and 24 are provided below under the heading "Claim Rejections Under 35 U.S.C. § 103(a)."

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 4-6, 21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Hedger. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Sherts. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Hedger and further in view of Sherts. Applicants traverse the rejections of these claims. As stated above, a discussion of the rejections of Claims 10 and 24 are provided below.

Under Section 103, the *prima facie* case of obviousness is established only if the cited references, alone or in combination, disclose each of the limitations of the recited claims. Additionally, as a general rule, a conclusion of obviousness requires a determination as to whether there was an *apparent reason* to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007).

Independent Claim 1

The Office Action contends that Loney discloses all of the claimed features except for the first engagement surface being a tongue positioned above a bottom surface of the channel that allows the wire to be compressed against the first engagement surface and the second engagement surface of the slider. The Office Action contends that Hedger discloses a tongue (19) supported in a channel (15), including a first engagement surface or the "upper-surface of the tongue" positioned above a bottom surface of the channel, and a second engagement surface or "under-surface of the slider" that receives a wire (23) that is inserted in the channel and compresses the wire against the first engagement surface of the tongue. The Office Action then reaches the conclusion that it would have been obvious to one having ordinary skill in the art to modify the invention of Loney to include the tongue of Hedger to arrive at applicants' claimed invention.

Applicants agree with the Office Action that Loney fails to teach the use of a tongue having a first engagement surface and being positioned above the bottom surface of the open ended channel. However, applicants respectfully assert the proposed combination fails to teach each and every limitation of Claim 1. Moreover, applicants respectfully assert that there is no apparent reason to modify the device of Loney with the tongue of Hedger as proposed by the Office Action to arrive at applicants' inventions of Claim 1.

Loney is directed to a gripping device used in medical procedures that employ a guide wire or tube. The gripping device 8 purportedly discloses a generally cylindrical body member 10 with a longitudinal slot 12 for laterally receiving a medical shaft 14. A sliding member 16 is received within the slot 12 and is longitudinally movable relative to body member 10 along slanted guide rails to bring together engagement surface 38 of the body member 10 and engagement surface 48 of the sliding member 16 to hold medical shaft 14 tightly therebetween. See Col. 2, line 54-Col. 3, line 10; Col. 3, line 57-Col. 4, line 33; and Figs. 1B, 2B, 3B, and 4A.

Hedger, on the other hand, is directed to a wiring pen that comprises a body 10 formed with a bore 15 extending therethrough and a slot 14. The slot 14 carries a slider 16 that is formed with a tongue 19. Instead of being side-loaded, Hedger includes a hole 20 at the interface between the tongue 19 and the slider 16 for allowing a wire from a reel 21 carried at the end of the body 10 to be threaded longitudinally therethrough. See Figs. 4 and 6. As such, the configuration of the slider prohibits any possible side-loading of a wire. In operation, the knurled surface of the slider 16 is pressed downwardly to grip the wire between the upper surface of the tongue 19 and the under-surface of the slider 16.

Thus, if Loney is modified by the teachings of Hedger such that either the slider 16 of Hedger is utilized or that the slider 16 of Loney is modified to include the tongue 19 of Hedger,

as proposed by the Office Action, the resulting combination would prohibit the wire from being side-loaded, as specified by Claim 1, while still meeting the remaining requirements of Claim 1, namely, that the wire is compressed between the first engagement surface of the tongue and the second engagement surface of the slider so that rotation of the body portion applies torque to the wire. Therefore, the proposed combination of Loney and Hedger fails to disclose each and every element of Claim 1.

The Office Action argues at paragraph 24 that one of ordinary skill would know how to make and modify the invention such that the teachings of Hedger may be incorporated while still allowing the wire to be side loaded. Even assuming, *arguendo*, that this were true, which applicants specifically deny, an apparent reason to combine the known elements in the fashion claimed by the patent application at issue is required. However, the Office Action has provided no evidence of why one skilled in the art would combine the references in the manner claimed. Specifically, the Office Action has provided no evidence as to why one skill in the art would even look to combine the teaching of Hedger with Loney or why one of ordinary skill in the art would modify the resulting combination in the specific manner recited in Claim 1. Applicants believes that the Office Action is using hindsight reasoning, which is not permissible, to combine the references in the manner set forth in the Office Action, and but for the knowledge gained by reviewing applicants' specification, the Office Action would not have combined the references in the manner claimed.

For at least the reasons described above, applicants respectfully assert there is no apparent reason to combine Loney and Hedger as proposed by the Office Action. Moreover, applicants respectfully assert that the proposed combination of Loney and Hedger fails to disclose each and every element recited in Claim 1. Therefore, applicants submit that a *prima facie* case of obviousness has not been established. Thus, applicants respectfully request the

pending rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn. Accordingly, applicants respectfully request withdrawal of the pending rejections under 35 U.S.C. § 103(a) of Claims 4-6, 21, and 23, which depend from allowable Claim 1.

Dependent Claim 4

In addition to the allowable combination of features recited in Claim 1, Claim 4 further recites that the first engagement surface of the tongue and the second engagement surface of the slider are angled in a similar manner with respect to the bottom surface of the open ended channel so that the wire is compressed therebetween. Contrastingly, both Loney and Hedger disclose horizontally oriented engagement surfaces. In particular, Loney expressly teaches at Col. 3, lines 35-41 that the bottom surface 38 of slot 12 (one of the engagement surfaces) is flat (longitudinally) so that when the medical shaft 14 is aligned within the body member 10, it is engaged and supported by the bottom surface 38 along the entire length of the slot 12 without bending the shaft 14. Hedger, on the other hand, illustrates in Fig. 7c that both engagement surfaces are horizontally orientated along the slot 14.

Thus, applicants respectfully assert from the foregoing that Loney and Hedger fail to teach each and every element of dependent Claim 4. Therefore, applicants submit that a *prima facie* case of obviousness has not been established. Thus, applicants respectfully requests the pending rejection of Claim 4 under 35 U.S.C. § 103(a) be withdrawn.

Dependent Claim 21

In addition to the allowable combination of features recited in Claim 1, Claim 21 further recites that the tongue is defined by the body member. Contrastingly, Hedger discloses that the tongue 19 is connected in a cantilevered manner to the slider 16. See Figs. 6 and 7a-7c. Thus, applicants respectfully assert from the foregoing that Looney and Hedger fail to teach each and every element of dependent Claim 21. Therefore, applicants submit that a *prima facie* case of

obviousness has not been established. Thus, applicants respectfully request the pending rejection of Claim 21 under 35 U.S.C. § 103(a) be withdrawn.

Independent Claim 10

The Office Action states that Loney teaches each of the elements of Claim 10 except for 1) a slider including an open ended channel and a close end that forms the engagement surface; and 2) a slider that is U-shaped. The Office Action contends that Hedger discloses a slider 16 that includes an open ended channel (referred to as "hole 20"), and an engagement surface (under surface of slider) that interfaces with the tongue 19. However, the Office Action states that Hedger, like Loney, fails to disclose a U-shaped slider. The Office Action then contends that Sherts discloses a U-shaped slider (106). The Office Action then reaches the conclusion that it would have been obvious to one having ordinary skill in the art to modify the invention of Loney to include the tongue of Hedger and the U-shaped slider of Sherts to arrive at applicants' claimed invention.

Clarifying amendments has been made to Claim 10. In particular, Claim 10 now recites that the slider has an open ended channel that is configured for laterally receiving the wire and being substantially aligned with the open ended channel of the body. Claim 10 was also amended to recite that the open ended channel of the slider defines an engagement surface.

The Office Action has characterized the hole 20 of the slider 16 in Hedger as an "open ended channel." Applicants respectfully disagree with this characterization. Although applicants respectfully disagree with the Office Action's characterization, applicants have amended Claim 10 to recite that the open ended channel of the slider is configured to laterally receive a wire therein. Contrastingly, the hole in Hedger is not capable of laterally receiving the wire. Applicants further assert that Loney and Sherts fail to correct the deficiencies of Hedger.

From the foregoing, it is clear that Loney, Hedger, and Sherts fail to teach each and every element of dependent Claim 10. Therefore, applicants submit that a *prima facie* case of obviousness has not been established. Thus, applicants respectfully request the pending rejection of Claim 10 under 35 U.S.C. § 103(a) be withdrawn. Accordingly, applicants respectfully request withdrawal of the pending rejection under 35 U.S.C. § 103(a) of Claim 24, which depends from allowable Claim 10.

Independent Claim 20

The Office Action states that Loney teaches each of the elements of Claim 20 except for: 1) a fixed wedge positioned on one of the side walls of the U-shaped channel; and 2) a slider having an engagement surface facing the wedge, wherein the slider is longitudinally movable towards the wedge to pinch the wire against the wedge. The Office Action contends that Sherts teaches an analogous device that comprises a channel (100b) that includes a wedge (104) fixed in a vertical direction and positioned on a side wall of the channel, and a slider (106) with an engagement surface (106a) facing the wedge, wherein the slider is longitudinally movable towards the wedge to pinch a wire against the wedge. The Office Action then reaches the conclusion that it would have been obvious to one of ordinary skill in the art to combine Loney with Sherts to arrive at applicants' claimed invention. Applicants respectfully disagree.

In particular, the Office Action contends that element 104, referred to as a clamp pad 104 in Sherts, has a wedge structure of being smaller on top and larger on bottom, thick at one end and tapering at the other, and thus constitutes a wedge. Applicants disagree with the Office Actions' characterization that element (104) is a wedge or is shaped like a wedge. Specifically, Sherts illustrates a side view of the clamp pad (104) in FIGURES 12b-12c. As best shown in FIGURES 12b-12c, the clamp pad is shaped as an inverted T. Applicants respectfully assert that

an inverted T does not constitute a wedge. In fact, the only structure that appears to be wedge-like is the angled cam surface 106a of slide button 106.

Although applicants respectfully disagree with the Office Action's contentions that the clamp pad 104 is a wedge, applicants have made clarifying amendments to Claim 20 so that the fixed wedge has an angled engagement surface. Applicants respectfully assert that the clamp pad 104 does not include an angled engagement surface.

Since Loney and Sherts, alone and in combination, fail to teach an open ended channel that includes a fixed wedge having an angled engagement surface positioned on one of the side walls of the open ended channel, the combination of Loney and Sherts proposed by the Office Action fails to teach each and every recited element of Claim 20. Accordingly, applicants assert that a *prima facie* case of obviousness has not been established. Therefore, applicants respectfully request the pending rejection of Claim 20 under 35 U.S.C. § 103(a) be withdrawn.

Dependent Claim 22

Dependent Claim 22 depends from Claim 1, and thus, contain all of the elements of Claim 1. Therefore, for at least the same reasons as discussed above with regard to Claim 1, Claim 22 is allowable over the cited references. Accordingly, applicants respectfully request withdrawal of the pending rejection under 35 U.S.C. § 103(a) with regard to Claim 22.

New Claim 25-26

New Claim 25 has been added to particularly point out and distinctly claim the novel aspects of the present invention. Applicants respectfully assert that newly submitted Claim 25 recites combinations of features neither disclosed nor rendered obvious by the prior art. In particular, new Claim 25 depends from Claim 20 and further recites that movement of the slider pinches the wire between the engagement surface of the slider and the angled engagement surface of the fixed wedge. As best shown in FIGURES 12a-12c of Sherts, the wire is not

pinched between the slider 106 and clamp pad 104. Instead, the wire is pinched between clamp pad 104 and the bottom surface of the channel 100b. Accordingly, applicants respectfully submit that new Claim 25 is in condition for allowance.

New Claim 26 has been added to particularly point out and distinctly claim the novel aspects of the present invention. Applicants respectfully assert that newly submitted Claim 26 recites combinations of features neither disclosed nor rendered obvious by the prior art. In particular, new Claim 26 depends from Claim 1 and further recites that the first engagement surface of the tongue faces the bottom surface of the open ended channel of the body portion. As best shown in FIGURES 7a-7c of Hedger, the engagement surface of the tongue is facing upwardly toward the bottom surface of the slider. Accordingly, applicants respectfully submit that new Claim 26 is in condition for allowance.

CONCLUSION

In light of the foregoing amendments and remarks, applicants submit that all of the claims of the present application are in condition for allowance. Thus, applicants respectfully request the allowance of all pending claims. If any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Brandon C. Stallman
Registration No. 46,468
Direct Dial No. 206.695.1708

BCS:jlb

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100